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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,279	06/23/2003	Steven Gerard Mayorga	06223P USA	9141

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AIR PRODUCTS AND CHEMICALS, INC.
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EXAMINER	
MOORE, MARGARET G	
ART UNIT	**PAPER NUMBER**
1712	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,279	MAYORGA ET AL.	
	Examiner	Art Unit	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 to 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 3, 8 to 14* is/are rejected.

7)☒ Claim(s) *4 to 7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 to 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 to 14, 19 to 28 of U.S. Patent No. 6,858,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of stabilizing in instant claims 1 and 8 embraces stabilizing against polymerization during extended periods of heating and as such the method in claims 6 and 28 of '697 fall within the breadth of instant claims 1 and 8. That is, instant claims 1 and 8 are slightly broader but fully inclusive of the process claims in '697. The methods of claims 1 and 8 also embrace methods in which additional inhibitors such as neutral to weakly acid polymerization inhibitor are added, and as such claims 2 to 5 and 10 to 12 fall within the breadth of the instant claims. In addition while the claims in '697 are not specifically drawn to a process for stabilizing against polymerization caused by oxygen, carbon dioxide and/or nitrogen trifluoride, such a result would appear to be inherently found in the processes claimed therein, meeting the requirements of instant claim 10. For composition claims 12 and 13, note that these compositions are open to the component (b) as found in claims 13 and 19 to 24 of '697. In addition, claims 12 and 14 are broader than, but fully inclusive of, claims 25 and 26 since the instant claims need not be stabilized for extended period of heating.

3. Claims 1 to 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 7, 9 to 20 and 23 are of copending Application No. 10/650,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because the stabilized cyclosiloxane in claim 1, as defined by claim 2 (stabilized with a free radical inhibitor), claim 5 (tetramethylcyclotetrasiloxane) and claims 12 to 15, is fully embraced by instant claim 12. That is, when the cyclosiloxane in '282 is that of claim 5, and when it is stabilized by a free radical inhibitor such as that found in claims 12 to 15, the stabilized siloxane fully meets the requirements of claims 12 to 14. Note too that the process of stabilizing, claim 16, is similarly met by the breadth of instant claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 8, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Burnier.

This rejection is consistent with that made in the parent application. See the paper dated 2/13/04, paragraph 5. Burnier teaches organosilicon compositions containing stabilizers, specifically a hindered phenol and a hindered amine or aromatic amine. Particularly note Example 4, which combines MHCS (a cyclosiloxane mixture

defined on the top of column 8 and containing 1,3,5,7 tetramethylcyclotetrasiloxane) with a hindered phenol and a hindered amine. This forms a distinct mixture that anticipates the instant claims. While Burnier subsequently react the cyclosiloxane this clearly forms a composition containing (a) and (b) as found in claims 12 and 13

Regarding claims 1 and 8, the process therein can stabilize against any type of polymerization. Even though the cyclosiloxane in Burnier subsequently undergoes hydrosilation, it is stabilized against other types of polymerization such as that caused by oxidation and thus meets this limitation. The Examiner notes that the phrase "stabilizing 1,3,5,7 tetramethylcyclotetrasiloxane against polymerization" as used in the context of the instant claims does not refer to hydrosilation. On the other hand, for claims 1, 8 and 10, since Burnier anticipate each claimed process step, any property inherently associated with the claimed process will likewise be inherently associated with the process in Burnier.

7. Claims 2, 3, 9, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnier.

This rejection is consistent with that made in the parent application, see paper dated 2/13/04, paragraph 7.

With regard to the particular free radical scavenger, note that column 7, line 15, teaches 2,6 di-t-butylphenol. As such one having ordinary skill in the art would have been motivated by the teachings of Burnier to use such a hindered phenol in the process of Example 4, thereby rendering this claim obvious. Note that it is it is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances.

8. Claims 4 to 7 are objected to as being based upon a rejected base claim, but would be allowable if rewritten into independent form. The prior art fails to teach or adequately suggest a free radical scavenger to cyclotetrasiloxane ratio as claimed. Example 4 uses considerably more scavenger than required by these claims. Column

7, lines 45 to 50, teach an amount of scavenger based on total grams of resin, but this fails to adequately suggest the amount of particular cyclosiloxane and scavenger as claimed. Note for instance that the total amount of resin in Burnier includes reactants other than the SiH containing siloxane.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
6/8/05